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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/786,279 | 02/24/2004 | Mark Banister | MEDIPACS 04.02 | 2485 |
| 27667 | 7590 | 07/18/2006 | EXAMINER | |
| HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718 | | | BARTON, JEFFREY THOMAS | |
| | | | ART UNIT | PAPER NUMBER |

1753

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,279

Applicant(s)

BANISTER, MARK

Examiner

Jeffrey T. Barton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The response filed on 21 April 2006 does not place the application in condition for allowance.

Status of Objections and Rejections Pending Since the Office Action of 16 February 2006

2. The objection to the drawings is maintained in part.
3. The objection to the specification is withdrawn due to Applicant's amendment.
4. The rejections of claims 8, 9, 14, 15, and 21 under 35 U.S.C. §112(2) are withdrawn due to Applicant's amendment.
5. All other previous rejections are maintained.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference number 6 in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted

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after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 36 is objected to because the term "source of illuminators" in line 1 is unclear. Based on claim 17, it appears "source of illumination" was intended. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 11, 13, 15, 18-21, 27, 28, and 31-33 are rejected under 35 U.S.C. 102(b) as being Murasko et al, U.S. Patent Application Publication 2002/0159245. None of the instant claims is fully supported by provisional application

60/448,888. Accordingly, the instant claims have a filing date of 02/24/2004. Murasko et al has a 102(b) date of 10/31/2002.

Murasko et al teaches a laminated electrical device comprising stacked layers including a substrate 202 that can be glass or plastic, i.e., rigid or flexible; a photocell 208 (i.e., a photovoltaic); a device 204, such as a thin film battery, for storing electricity produced by the photocell 208; a source of illumination 206; electrical circuitry 214 for connecting the components; and, as a protective surface, a light transmissive, electrically insulating material (see paragraphs 0023 to 0025). It is the Examiner's position that the electrical circuitry in Murasko et al's device inherently prevents electric current drain through the photocell. Since Murasko et al teaches the limitations of the instant claims, the reference is deemed to be anticipatory.

10. Claims 1, 2, 12, 15, 18-21, 23, 27, 28, and 31-33 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2003-257223, herein referred to as JP '223. None of the instant claims is fully supported by provisional application 60/448,888. Accordingly, the instant claims have a filing date of 02/24/2004. JP '223 has a 102(a) date of 09/12/2003.

JP '223 teaches a laminated electrical device comprising stacked layers including a substrate 13; a solar cell module 30; electric double layer capacitor 20; light emitting diode 10; electrical circuitry 214 for connecting the components (Figure 3); and a protective surface 32 (see Figures 1-3). It is the Examiner's position that the electrical circuitry in JP '223's device inherently prevents electric current drain through the solar

cell module. Since JP '223 teaches the limitations of the instant claims, the reference is deemed to be anticipatory.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-11, 13-33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murasko et al, U.S. Patent Application Publication 2002/0159245.

Murasko et al teaches a laminated electrical device comprising stacked layers including a substrate 202 that can be glass or plastic, i.e., rigid or flexible; a photocell 208 (i.e., a photovoltaic); a device 204, such as a thin film battery, for storing electricity produced by the photocell 208; a source of illumination 206; electrical circuitry 214 for

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connecting the components; and, as a protective surface, a light transmissive, electrically insulating material (see paragraphs 0023 to 0025). It is the Examiner's position that the electrical circuitry in Murasko et al's device inherently prevents electric current drain through the photocell. Murasko et al teaches the limitations of the instant claims other than the difference which is discussed below.

Murasko et al does not specifically teach such features as an adhesive and removable covering, or a thermally conductive layer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Murasko et al's device with such features so as to enable Murasko et al's device to be stuck to a surface and to prevent build-up of heat. As is known in the art, at high temperatures, a solar cell becomes less efficient. Accordingly, there is sufficient motivation to prevent buildup of heat.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murasko et al as applied to claims 1-11 and 13-33 above, and further in view of Green et al (U.S. Patent 5,782,552) and JP 62-106671 (JP '671).

Murasko et al, as relied upon for the reasons recited above, teaches the limitations of claim 12, the difference being that Murasko et al does not specifically teach the use of a capacitor in place of its battery. Green et al teaches a light emitting diode (LED), a rechargeable capacitor and a solar cell, wherein the solar cell can charge the capacitor (see col. 2, lines 27-65). JP '671 teaches that a solar cell and capacitor can be laminated (see the Figure 1). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have used a capacitor to store electricity in Murasko et al's device in place of the thin film battery because a solar cell can charge a capacitor, as shown by Green et al, and a solar cell and capacitor can be laminated, as shown by JP '671.

15. Claims 1-12, 14-33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-257223, herein referred to as JP '223. None of the instant claims is fully supported by provisional application 60/448,888. Accordingly, the instant claims have a filing date of 02/24/2004. JP '223 has a 102(a) date of 09/12/2003.

JP '223 teaches a laminated electrical device comprising stacked layers including a substrate 13; a solar cell module 30; electric double layer capacitor 20; light emitting diode 10; electrical circuitry 214 for connecting the components (Figure 3); and a protective surface 32 (see Figures 1-3). It is the Examiner's position that the electrical circuitry in JP '223's device inherently prevents electric current drain through the solar cell module. JP '223 teaches the limitations of the instant claims other than the difference which is discussed below.

JP '223 does not specifically teach such features as an adhesive and removable covering, or a thermally conductive layer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided JP '223's device with such features so as to enable JP '223's device to be stuck to a surface and to prevent build-up of heat. As is known in the art, at high temperatures, a solar cell

becomes less efficient. Accordingly, there is sufficient motivation to prevent buildup of heat.

Response to Arguments

16. Applicant's arguments filed on 21 April 2006 have been fully considered but they are not persuasive.

Applicant asserts that the claims are fully supported by provisional application 60/448,888. Applicant is clearly in error. As clearly shown in the Table provided in Applicant's remarks, the '888 application provides support for a tape, not a broadly recited "laminated electrical device"; for a base sealing layer, not a broadly recited "substrate"; and for a battery, not a broadly recited "device for storing electricity". The one-page specification and two figures of the '888 application do not enable the breadth of what is instantly claimed. Therefore, none of the instant claims are fully supported by the provisional application and the claims are properly treated as having an effective filing date of 24 February 2004.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Barton whose telephone number is (571) 272-1307. The examiner can normally be reached on M-F 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

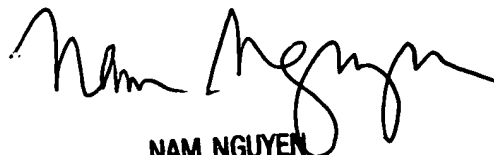
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JTB

7 July 2006

A handwritten signature in black ink, appearing to read 'Nam Nguyen', is written over a rectangular stamp.

NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700